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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,822	03/06/2002	A. Kent Sievers	1565.006US1	7995

21186 7590 05/10/2006

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EXAMINER

CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/092,822	Applicant(s) SIEVERS ET AL.	
	Examiner David G. Cervetti	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed February 27, 2006, have been fully considered.
2. Claims 1-26 are pending and have been examined.

Response to Amendment

3. The objection to claim 16 was intended for the then only occurring "is", not for the "if". Please see new objection below.
4. The rejection of claims 1, 7, 14, and 21 under 35 U.S.C. 112, second paragraph, is withdrawn.
5. Applicant's arguments that the Prior Art does not teach or suggest sending from a recipient data to a remote device for scanning are not persuasive. Ji (US Patent 5,889,943) teaches different modules to perform different tasks in the same or different node (see Abstract). The teachings of Ji and the state of the art at the time the invention was made make using remote processing of data conventional and well known. On a smaller scale, Ji's processing of encoded content (figure 8B) reads on decrypting text and transferring content for virus detection. Ji uses a module residing not necessarily in the same node (abstract). Therefore, Applicant's argument that the prior art does not suggest transferring from a recipient to a remote location is not persuasive.

Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set

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forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Claim Objections

7. Claim 16 is objected to because of the following informalities: "The email system of claim 15, wherein the scan validates the email **message is the email messages is free of viruses**" (emphasis added). Perhaps "wherein the scan validates the email message if the email message[s] is free of viruses" or "wherein the scan validates the email message if the email messages **are** free of viruses" was intended. Appropriate correction is required.

8. Claim 17 is objected to because of the following informalities: "if **the result** indicates" (emphasis added). Perhaps "if the **flag** indicates" was intended, since what the local email set of executable instructions receives from the server is the flag. Appropriate correction is required.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 21-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 21 states "an email message residing on a computer readable medium operable to be remotely validated, comprising...". The claim has been drafted in what appears to be intended to be executable instructions residing on a computer readable medium to remotely validate an email message. An email message is not "operable", as

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is data not code. Data residing in a medium is considered non-statutory subject matter.

Claims 22-26 are rejected based on its dependency from claim 21.

11. To expedite a complete examination of the application, the claims rejected under 35 U.S.C. 101 (non-statutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. Claims 1-3, 5-19, 21-22, and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Ranger et al. (US Patent 6,393,568, hereinafter Ranger).

Regarding claim 1, Ranger teaches

- receiving, at a recipient, the email message in a first encrypted format from a sender of the email message (abstract, column 2, lines 25-67);
- decrypting, at the recipient, contents of the email message from the first encrypted format (column 3, lines 1-67);
- transferring, from the recipient, the decrypted email message contents to a remote server (column 3, lines 1-67, column 7, lines 1-58); and
- receiving, at the recipient, from the remote server a status flag, wherein a value associated with the status flag indicates whether the contents are free from a virus or are free from objectionable material as validated by the remote server (column 5, lines 1-67, column 6, lines 1-67).

Regarding claim 7, Ranger teaches

- receiving the data message from a client, wherein the data message was previously received at the client and sent from a sender of the data message to the client (abstract, column 2, lines 25-67), wherein the client decrypts the data message before the data message is processed by the client (column 3, lines 1-67), and wherein the client is external and remote to the method and communicates with the method over a network by sending the data message for scanning (column 3, lines 1-67, column 7, lines 1-58);
- scanning the data message for viruses (column 3, lines 1-67, column 7, lines 1-58); and

- sending a validation flag to the client, wherein the validation flag includes a value indicating whether the data message includes zero or more of the viruses (column 5, lines 1-67, column 6, lines 1-67).

Regarding claim 14, Ranger teaches

- a local email set of executable instructions residing on a client (abstract, column 2, lines 25-67);
- a remote validation set of executable instructions residing on a server (abstract, column 2, lines 25-67); and
- wherein the email message is received by the local email set of executable instructions from a sender, who intends the email message for the client, and local email set of executable instructions decrypts the email message (column 3, lines 1-67) and then streams the email message to the remote validation set of executable instructions located on the server in an unencrypted format or in a different encrypted format from what was received on the client from the sender (column 3, lines 1-67, column 7, lines 1-58) and wherein the email message is scanned and a validation flag associated with a result of the scan is sent to the local email set of executable instructions back on the client (column 5, lines 1-67, column 6, lines 1-67).

Regarding claim 21, Ranger teaches

- a first encrypted format associated with content data of the email message, wherein an email client which is an intended recipient of the email message (abstract, column 2, lines 25-67),
- decrypts the first encrypted format to render the content data (column 3, lines 1-67), and wherein the first encrypted format is received on the email client from a sender of the content data, the sender directs the email message to the recipient; and
- a second encrypted format associated with the content data, wherein the email client generates the second encrypted format, and wherein the email client transfers the second encrypted format of the email message to a remote server (column 3, lines 1-67, column 7, lines 1-58), which is external to the email client and to an environment of the email clients and wherein the content data is rendered by and at the remote server by decrypting the second encrypted format, and wherein the remote server scans the content data for viruses (column 5, lines 1-67, column 6, lines 1-67).

Regarding claim 2, Ranger teaches encrypting the email message in a second encrypted format before transferring the email message to the remote server (column 3, lines 1-67, column 4, lines 1-67).

Regarding claim 3, Ranger teaches accessing the email message for use, if the value of the status flag indicates the remote server validated the email message (abstract, column 2, lines 25-67).

Regarding claim 5, Ranger teaches wherein in receiving the status flag, if the value of the status flag indicates the remote server validated the email message, then subsequent accesses made to the email message do not result in the email message being transferred to the remote server for validation (column 3, lines 1-67, column 6, lines 1-67).

Regarding claim 6, Ranger teaches wherein in transferring the email message, the email message is streamed to the remote server (column 5, lines 1-67, column 6, lines 1-67).

Regarding claim 8, Ranger teaches decrypting the data message before scanning the data message (column 3, lines 1-67, column 4, lines 1-67).

Regarding claim 9, Ranger teaches wherein in decrypting the data message, the data message is decrypted using a public key of the client (column 3, lines 1-67, column 4, lines 1-67).

Regarding claim 10, Ranger teaches wherein in receiving the data message, the data message is an email message and the client is an email client (abstract, column 2, lines 25-67).

Regarding claim 11, Ranger teaches wherein in receiving the data message, the data message is received from an operating system residing on the client (abstract, column 2, lines 25-67).

Regarding claim 12, Ranger teaches wherein in scanning the data message, a scanning set of executable instructions is selectively executed to scan the data

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message for zero or more of the viruses (abstract, column 2, lines 25-67, column 3, lines 1-67).

Regarding claim 13, Ranger teaches wherein in receiving the data message, the data message is received as a data stream from the client and scanned as the data stream is received (column 5, lines 1-67, column 6, lines 1-67).

Regarding claim 15, Ranger teaches wherein the local email set of executable instructions accesses the email message if the result indicates the scan validated the email message (column 3, lines 1-67, column 6, lines 1-67).

Regarding claim 16, Ranger teaches wherein the scan validates the email message is the email messages is free of viruses (column 3, lines 1-67, column 6, lines 1-67).

Regarding claim 17, Ranger teaches wherein the local email set of executable instructions removes the data message if the result indicates the scan did not validate the email message (column 3, lines 1-67, column 6, lines 1-67).

Regarding claim 18, Ranger teaches wherein communications between the local email set of executable instructions and the remote validation set of executable instructions are secure (column 1, lines 1-67, column 3, lines 1-67).

Regarding claim 19, Ranger teaches wherein public and private key pairs associated with the client and the server are used to encrypt and authenticate the communications (column 3, lines 1-67, column 4, lines 1-67).

Regarding claim 22, Ranger teaches wherein a validation flag indicating whether zero or more of the viruses are detected in the content data is generated by the remote server and sent to the email client (column 3, lines 1-67, column 6, lines 1-67).

Regarding claim 24, Ranger teaches wherein the second encrypted format is generated by using a private key for the email client and a public key for the remote server (column 3, lines 1-67, column 4, lines 1-67).

Regarding claim 25, Ranger teaches wherein the email client accesses the content data for use when the remote server detects no viruses (abstract, column 2, lines 25-67, column 3, lines 1-67).

Regarding claim 26, Ranger teaches wherein the content data includes text data and attachment data (abstract, column 2, lines 25-67, column 3, lines 1-67).

Claim Rejections - 35 USC § 103

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims 4, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranger.

Regarding claims 4, 20, and 23, Ranger teaches using encryption and email messages (abstract, column 2, lines 25-67, column 3, lines 1-67). Ranger does not expressly disclose using the Secure Multipurpose Internet Mail Extension (S/MIME) format. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any other kind of encryption that could be applied to the system of Ranger. One of ordinary skill in the art would have been

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motivated to perform such a modification to protect content (Ranger, column 1, lines 5-67, column 7, lines 1-60).

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHRISTOPHER REVAK
PRIMARY EXAMINER

CEL 5/9/06

DGC